



RECEIVED

MAR 15 2001

CENTER 1600

PTO/SB/29 (8/98)

Approved for use through 09/30/2000. OMB 0851-0032

Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**CONTINUED PROSECUTION APPLICATION (CPA)
REQUEST TRANSMITTAL**

Submit an original, and a duplicate for fee processing.

(Only for Continuation or Divisional applications under 37 C.F.R. § 1.53(d))

CHECK BOX, if applicable:

☐ DUPLICATE

Address to:

Assistant Commissioner for Patents
Box CPA
Washington, DC 20231Attorney Docket No.
of Prior Application

0050/48429/UP

First Named Inventor

BORNSCHEUER et al.

Examiner Name

KERR

Group / Art Unit

1652

Express Mail Label No.

This is a request for a ☒ continuation or ☐ divisional application under 37 C.F.R. § 1.53(d),
(continued prosecution application (CPA)) of prior application number 09 / 161,680,
filed on 9/28/98, entitled ALTERATION OF THE SUBSTRATE SPECIFICITY OF ENZYMES

NOTES

FILING QUALIFICATIONS: The prior application identified above must be a nonprovisional application that is either: (1) complete as defined by 37 C.F.R. § 1.51(b), or (2) the national stage of an international application in compliance with 35 U.S.C. 371. A Notice will be placed on a patent issuing from a CPA, except for reissues and designs, to the effect that the patent issued on a CPA and is subject to the twenty-year patent term provisions of 35 U.S.C. § 154(a)(2). Therefore, the prior application of a CPA may have been filed before, on or after June 8, 1995.

C-I-P NOT PERMITTED: A continuation-in-part application cannot be filed as a CPA under 37 C.F.R. § 1.53(d), but must be filed under 37 C.F.R. § 1.53(b).

EXPRESS ABANDONMENT OF PRIOR APPLICATION: The filing of this CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA. 37 C.F.R. § 1.53(b) must be used to file a continuation, divisional, or continuation-in-part of an application that is not to be abandoned.

ACCESS TO PRIOR APPLICATION: The filing of this CPA will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of 37 C.F.R. § 1.14 to access to, copies of, or information concerning, the prior application may be given similar access to, copies of, or similar information concerning, the other application or applications in the file jacket.

35 U.S.C. 120 STATEMENT: In a CPA, no reference to the prior application is needed in the first sentence of the specification and none should be submitted. If a sentence referencing the prior application is submitted, it will not be entered. A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request, 37 C.F.R. § 1.78(e).

1. ☐ Enter the unentered amendment previously filed on _____
under 37 C.F.R. § 1.116 in the prior nonprovisional application.
2. ☒ A preliminary amendment is enclosed.
3. This application is filed by fewer than all the inventors named in the prior application, 37 C.F.R. § 1.53 (d)(4).
 - a. ☐ DELETE the following inventor(s) named in the prior nonprovisional application:

 - b. ☐ The inventor(s) to be deleted are set forth on a separate sheet attached hereto.
4. ☐ A new power of attorney or authorization of agent (PTO/SB/81) is enclosed.
5. Information Disclosure Statement (IDS) is enclosed:
 - a. ☐ PTO-1449
 - b. ☐ Copies of IDS Citations

[Page 1 of 2]

Burden Hour Statement: This form is estimated to take 0.4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CPA, Washington, DC 20231.

CLAIMS	(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) CALCULATIONS
TOTAL CLAIMS (37 C.F.R. § 1.16(c) or (j))	10	-20* =		x \$ _____ =	\$ _____
INDEPENDENT CLAIMS (37 C.F.R. § 1.16(b) or (i))	1	-3** =		x \$ _____ =	\$ _____
MULTIPLE DEPENDENT CLAIMS (if applicable) (37 C.F.R. § 1.16(d))				+ \$ _____ =	\$ _____
				BASIC FEE (37 C.F.R. § 1.16)	\$ _____
				Total of above Calculations =	\$ _____
Reduction by 50% for filing by small entity (Note 37 C.F.R. §§ 1.9, 1.27 & 1.28).					
* Reissue claims in excess of 20 and over original patent.					
** Reissue independent claims over original patent.					
TOTAL =					710.00

6. Small entity status:

- a. ☐ A small entity statement is enclosed, if (b) and (c) do not apply.
 b. ☐ A small entity statement was filed in the prior nonprovisional application and such status is still proper and desired.
 c. ☐ Is no longer claimed.

7. The Commissioner is hereby authorized to credit overpayments or charge the following fees to Deposit Account No. _____:

- a. ☐ Fees required under 37 C.F.R. § 1.16.
 b. ☐ Fees required under 37 C.F.R. § 1.17.
 c. ☐ Fees required under 37 C.F.R. § 1.18.

8. ☒ A check in the amount of \$ 710.00 is enclosed.

9. ☐ New Attorney Docket Number, if desired _____

(Prior application Attorney Docket Number will carryover to this CPA unless a new Attorney Docket Number has been provided herein.)

10. a. ☐ Receipt For Facsimile Transmitted CPA (PTO/SB/29A)

b. ☒ Return Receipt Postcard (Should be specifically itemized. See MPEP 503)

11. ☒ Other: Authorization is hereby given to charge any deficiency in fees to DEP ACCT 11-0345

NOTE:

The prior application's correspondence address will carry over to this CPA UNLESS a new correspondence address is provided below.

12. NEW CORRESPONDENCE ADDRESS

☐ Customer Number or Bar Code Label

or ☐ New correspondence address below

(Insert Customer No. or Attach bar code label here)

Name	Herbert B. KEIL				
Address	KEIL & WEINKAUF				
	1101 Connecticut Avenue, N.W.				
City	Washington, D.C. 20036				
	State	Zip Code			
Country	USA	Telephone	(202) 659-0100	Fax	(202) 659-0105

13. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print/Type)	Herbert B. Keil
Signature	<i>Herbert B. Keil</i>
Registration No. (Attorney/Agent)	18,967
Date	March 12, 2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

BORNSCHEUER et al.

Serial No. 09/161,680

Filed: September 28, 1998

For: THE ALTERATION OF THE SUBSTRATE SPECIFICITY OF ENZYMES



Art Unit: 1652

Examiner: Kerr, K

RECEIVED

MAR 15 2001

TECH CENTER 1600/2900

16/E
J.G.J
3/15/01

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

PRELIMINARY AMENDMENT

Sir:

Kindly amend the above-identified application as follows, in accordance with 37

CFR 1.115.

IN THE CLAIMS

Please rewrite the following claims:

Sub 1
E1
1. (amended) A method for altering [alerting] the substrate specificity of an enzyme wherein the affinity for a new substrate, measured as k_{cat}/k_m , rises from zero or almost zero, to greater than zero, such that the enzyme converts the new substrate, which method comprises the steps of: